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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,758	03/29/2001	Takashi Yamamoto	35.C15234	2682

5514 7590 04/28/2004

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EXAMINER

LAO, LUN YI

ART UNIT	PAPER NUMBER
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2673

DATE MAILED: 04/28/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/819,758

Applicant(s)

YAMAMOTO ET AL.

Examiner

Lao Y Lun

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2004.
2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
4a) Of the above claim(s) 6-10 and 16-18 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-5, 11-15 and 19-23 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The amendment filed on March 29, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the control apparatus determine according to the control signal, whether or not to transmit a command for operating the specific function from the control apparatus to the controlled apparatus.

The original specification disclose the control apparatus for transmitting a second control signal for specifying any of the specific operation on the basis of an operation for the second operation unit to the controlled device(see paragraph #12).

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

2. Claims 1-5, 11-15 and 19-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification fails to disclose the recitations of "the control apparatus determine according to the control signal, whether or not to transmit a command for operating the specific function from the control apparatus to the controlled apparatus" in claims 1, 4, 11, 14, 19 and 22; "the control apparatus is adapted to determine according to the control signal whether or not to move a cursor on the operation panel" in claims 3, 13 and 21 and "the control apparatus is adapted to change the operation panel according to data transmitted from the controlled apparatus" in claims 5, 15 and 23.

The original specification disclose the control apparatus for transmitting a second control signal for specifying any of the specific operation on the basis of an operation for the second operation unit to the controlled device(see paragraph #12); the controller moves a cursor displayed on the display panel on the basis of the operation for the first operation unit(see claim 3) and first operation means for operating an operation panel having a plurality of display elements corresponding to predetermined operations supplied from a controlled device to a controller(see paragraph #16). It is unknown how the control apparatus determine, according to the control signal transmitted from the operation apparatus(130), whether or not to transmit a command for operating the specific function from the control apparatus(120) to the controlled apparatus(100, 110); and what is the control signal.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 4, 11, 12, 14, 19, 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Florin et al(5,594,509).

As to claims 1, 2, 4, 11, 12, 14, 19, 20 and 22, Florin et al teaches a communication system comprising a control apparatus(54) (see figures 1, 2 and column 8, lines 31-49); a control apparatus(54) adapted to receive an operation panel for operating a controlled apparatus(56, 57, 58) from the controlled apparatus(54) and to display the operation panel(420) on a display unit(180); an operation apparatus(60) having a first operation unit(145, 146, 148, 150, 155) for operating the operation panel(420) (see figures 4a-5a, 36; abstract; column 3, lines 9-16 and column 12, lines 21-32) and a second operation unit(120, 122, 125, 130, 132, 142, 162, 164, 166, 168, 170) for operating a specific function(e.g. volume up or down, channel up or down, rewind, stop or record) of the controlled apparatus(56, 57, 58) (see figures 4a-5a; column 11, lines 50-68 and column 12, lines 1-45)

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and the control apparatus for receiving a control signal from the operation apparatus(60) and transmitting a command for operating the specific function(e.g. rewind, stop or record) from the control apparatus(54) to the controlled apparatus(156, 157, 158)(see figures 1-2, 36; column 8, lines 50-67; column 9, lines 1-25; column 12, lines 38-62; column 21, lines 56-68 and column 22, lines 1-22).

It would have obvious to have the control apparatus(54) to receiving a control signal and to determine whether or not to transmit a command for operating specific function to the controlled apparatus(56, 57, 58) since the pointing signal(145, 146, 148, 150) would not transmit to the controlled apparatus(56, 57, 58) for operating the specific function(e.g. rewind, stop or record, etc.)(see figures 1-2, 4a-5a; column 3, lines 9-16 and column 12, lines 20-53).

As to claims 2,12 and 20, Florin et al teach the control apparatus(54) for determine which one to the plural display elements(421, 422) in the operation panel(420) is operated(see figures 4a-5a, 36; column 21, lines 56-68 and column 22, lines 1-29).

As to claims 4, 14 and 22, Florin et al teach the control apparatus(54) to transmit a command for operating specific function(power on/off, volume up/down or channel up/down to the

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controlled apparatus(58) even the display panel is not display on the display unit(180) (see figures 1, 4a-5a and column 11, lines 50-56) .

5. Claims 3, 5, 13, 15, 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Florin et al(5,594,509) in view of Hahm(5,949,351).

Florin et al teach a method comprising a pointing device(up, down, left, right, 145, 146, 148, 150) and a transceiver(54) for receiving data from the controlled apparatus(56-58)(see figures 1, 2, 4a-5a; column 3, lines 9-16; column 8, lines 32-49 and column 10, lines 5-19). Florin et al fail to disclose a cursor on an operation panel and changing the operation panel according to data transmitted from the controlled apparatus.

Hahm teaches a method comprising a pointing device(105) for controlling the moving of a cursor(154) on an operation panel(103)(figures 1, 5 and column 5, lines 12-33) and changing the operation panel(103) according to data transmitted from the controlled apparatus(120, 130, 140)(see figure 1, 7-11; column 6, lines 1-18; column 7, lines 24-52 and column 8, lines 13-19). It would have been obvious to have modified Florin et al with the teaching of Hahm, so as to provide an indication(cursor) to notify a user which position has been activated on a display and update display information on the operation panel.

Response to Arguments

6. Applicant's arguments with respect to claims 1-5, 11-15 and 19-23 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Dunaway(5,450,079) teaches a remote controller(10) for controlling a plurality of controlled devices(12, 14, 16, 18).

Yashiro(5,418,527) teaches a remote control system for designating and operating one of the A/V devices.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lun-yi, Lao whose telephone number is (703) 305-4873.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala, can be reached at (703) 305-4938.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

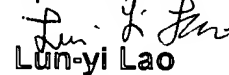
or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

April 26, 2004


Lun-yi Lao

Primary Examiner